

REMARKS

In a Final Office Action mailed on October 1, 2004, claims 6, 8-14, 25-30, 35-37 and 44-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boutros in view of Tseng; claims 15, 16, 18 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boutros in view of Pope; claims 17 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boutros in view of Pope and further in view of Volz; claims 21-24 and 39-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boutros in view of Volz; and claims 1-5, 42 and 43 were allowed. The § 103 rejections are discussed below.

Rejections of Claims 6, 8-14, 25-30, 35-37 and 44-48:

In the Final Office Action, the Examiner contends that the combination of Tseng and Boutros would have been obvious, "because mounting of the slot connector housing assembly on the motherboard would provide an interface between the inserted card/substrate ("SIMM") and the motherboard of the computer for use in communication systems such as a personal computer ("PC") system." Final Office Action, 3. Applicant states that although an attempt was made to supply the requisite suggestion or motivation for the modification of Tseng's computer in view of Boutros to derive the claimed invention, the Examiner has not set forth a *prima facie* case of obviousness.

More specifically, a *prima facie* case of obviousness requires that the Examiner show where the prior art contains the alleged suggestion or motivation for the modification of a reference. M.P.E.P. § 2143. Thus, the Examiner must show that one skilled in the art, *without knowledge of the claimed invention*, would have modified Tseng's computer in view of Boutros to draw the claimed invention (*emphasis added*). As best understood by Applicant, the Examiner contends that it would have allegedly been obvious to one of skill in the art to modify Tseng's SIMM card slot to incorporate features from Boutros' modular plug connector. However, the Examiner has not shown the suggestion or motivation for such a modification.

More specifically, in order to modify Tseng to modify the claimed invention, Tseng's SIMM connector must be modified so that the SIMM connector engages an edge profile of a substrate inside a slot of the SIMM slot connector housing assembly. In short, the Examiner has not shown why one skilled in the art would have made this modification, as Tseng

discloses latches 34 for this purpose. *See, for example,* Tseng 4:5-8. Furthermore, it is unclear whether this modification to Tseng would even work in Tseng's system, namely, modifying Tseng's system so the slot has a feature to engage to inserted SIMM card.

Therefore, in summary, the Examiner has failed to show the requisite suggestion or motivation to establish a *prima facie* case of obviousness for either independent claim 6, 11, 25, 28 and 35. Therefore, for at least this reason, withdrawal of the § 103(a) rejections of claims 6, 8-14, 25-30, 35-37 and 44-48 is requested.

§ 103 Rejections of Claims 15-20:

In the latest Office Action, the Examiner basically contends that Boutros and Pope can be combined or modified to derive the claimed invention. However, the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness. *In re Mills*, 916 F2d, 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01

Thus, a *prima facie* case of obviousness requires a suggestion or motivation for the modification of a reference to derive the claimed invention. M.P.E.P. § 2143. Because the Examiner still fails to show the alleged suggestion or motivation, a *prima facie* case of obviousness has not been set forth for independent claims 15 and 18. Therefore, Applicant requests withdrawal of the § 103(a) rejections of claims 15-20.

Rejections of Claims 21-24 and 39-41:

Once again, the Examiner is effectively rejecting independent claims 21 and 39 under 35 U.S.C. § 103(a) because the modification of Boutros in view of Volz can be made. However, as pointed out above, the fact that references can be combined or modified is sufficient to establish a *prima facie* case of obviousness. *In re Mills*, 916 F2d, 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The mere allegation that Volz teaches fins that may be thermally conductive is not a sufficient modification to modify the arrangement set forth in Boutros, because is directed to a relatively low-power modular Ethernet connector. Thus, in summary, the Examiner still fails to show where the prior art contains the alleged suggestion or motivation to modify Boutros' connector with the thermal features described in Volz. Without such a suggestion or motivation, a *prima facie* case of obviousness has not been set forth for either independent claim 21 or 39.

Therefore, for at least the reasons that are set forth above, withdrawal of the § 103 rejections of claims 21-24 and 39-41 is requested.

CONCLUSION

In view of the foregoing, withdrawal of the § 103 rejections and a favorable action in the form a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees, or credit any overpayment to Deposit Account No. 20-1504 (ITL.0519US).

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Respectfully submitted,



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